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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,713	06/14/2005	Walter Haussecker	022862-1041	2416
23409 7590 10/21/2010 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
LUONG, VINH				
ART UNIT		PAPER NUMBER		
3656				
MAIL DATE		DELIVERY MODE		
10/21/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,713

Applicant(s)

HAUSSECKER ET AL.

Examiner

Vinh T. Luong

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-19,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 2,6,11-13,15-17,19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-10,14,18, and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Proficiency's Patent Drawing Review (PTO-544)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Appendices 1 and 2

1. In view of the appeal brief filed on August 13, 2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Richard WL Ridley/

Supervisory Patent Examiner, Art Unit 3656

2. The amendments filed on August 13, 2010 has been entered.

3. Claims 2, 6, 11-13, 15-17, 19, and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 10, 2009.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 4, 5, 7-10, 14, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hager et al. (WO 01/61133 A1 cited in the specification) in view of Cadle et al. (US 6,422,755).

Claims 1 and 9

Hager teaches a drive unit for actuating drives in a motor vehicle with a first housing part 2 and a second housing part 15 connected to the first housing part 2 by means of connecting elements 4, wherein the first housing part 2 features receptacles 5 for the connecting elements 4, and the first and second housing parts 2 and 15 are assigned bearing functions for an armature shaft 14.

Hager teaches the invention substantially as claimed. See the translation attached. However, Hager does not teach the receptacles embodied as centering holes for corresponding centering pins arranged on the second housing part and the second housing part featuring counter receptacles for the connecting elements surrounding at least partially by the centering pins.

As best seen in FIGS. 30a and 30b, Cadle teaches the receptacles embodied as centering holes 634 and 636 (FIG. 30a) for corresponding centering pins 630 and 632 arranged on the second housing part 622, the second housing part 622 featuring counter receptacles/bolt holes (see Appendix 1 hereinafter "App. 1") for the connecting elements/bolts surrounding at least partially by the centering pins 630 and 632 and the first and second housing parts 620 and 622 in order to be assigned bearing functions to avoid the connecting elements/bolts bearing against the sides of the bolt holes (Cadle 10:5-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the receptacles embodied as centering holes for centering pins arranged on Hager's second housing part and Hager's second housing part featuring counter receptacles for Hager's connecting elements surrounding at least partially by the centering pins in order to be assigned bearing functions to avoid the connecting elements/bolts bearing against the sides of the bolt holes as taught or suggested by Cadle. The modification of Hager's drive unit by forming the receptacles embodied as centering holes for centering pins as taught or suggested by Cadle would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

Claim 4

Cadle's centering pins 630 and 632 embodied to be sleeves (FIGS. 30a and 30b).

Claims 5 and 14

See lead-in bevels (at 630 or 632 in FIGS. 30a and 30b) formed on Cadle's centering pins 630 and 632.

Claims 7 and 18

Hager teaches the centering (bore) holes (not shown) arranged as through bore holes in a flange for the connecting element 4 passing through as seen in Hager's FIG. 1 (App. 2) and described in Applicant's Spec. ¶ 3. To choose the thickness of Hager's centering holes such that it is greater than the height of the centering pin would have been a matter of choice in design

since the claimed structures and the function they perform are the same as the prior art. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) citing *In re Gal*, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992). See also *stare decisis* regarding changes in size or proportion in MPEP § 2144.04.

Claim 8

Cadle's centering pin 630 or 632 forms a clearance fit together with the centering holes 634 or 636. (Cadle 2: 9-15, 7:7-27).

Claim 10

Hager's centering bore holes include pocket or through holes. See Applicant's admission in Spec., ¶ 3 quoted below:

“The pole pot is composed of a deep-drawn, smoothed-down, cylindrical tube on whose open end a flange is formed in which holes to accommodate screws are left open. Formed in the flange of the gear housing are *pocket threads into which the screws are screwed* thereby solidly connecting the two parts of the housing with one another.” (Emphasis added).

Claim 23

See claim 1 above. In addition, Cadle teaches the centering pins 630, 632 and the second housing part 622 formed as one unitary piece in order to reduce the cost of manufacturing (Cadle 1:66-2:8). In addition, as noted, the determination of patentability is based on the product itself, not by its method of production, such as, injection molding. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006); and MPEP § 2113.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Hager's centering pins and second housing part as one unitary piece

by, e.g., injection molding in order to reduce the cost of manufacturing as taught or suggested by Cadle. *KSR, supra*.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kim (centering pins 30 in FIG. 4), Ursel et al. (connecting element in FIG. 1), and DeCesare (centering pins 28a-30b).

7. Applicant's arguments filed on October 27, 2009; May 18, 2010; and August 13, 2010 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1, 4, 5, 7-10, 14, 18, and 23 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656